

REMARKS

Claims 1-12 were pending in the Application. Claims 8-12 are cancelled without prejudice or disclaimer. Hence, claims 1-7 are pending.

Claims 1-7 are rejected under 35 U.S.C. §103(a). Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request the Examiner to reconsider and withdraw these rejections.

I. REJECTIONS UNDER 35 U.S.C. §103(a):

The Examiner has rejected claims 1-7 under 35 U.S.C. §103(a) as being unpatentable over Applicants' Admitted Prior Art (hereinafter "AAPA") in view of James (U.S. Publication No. 2003/0212862). Applicants respectfully traverse these rejections for at stated below and respectfully request the Examiner to reconsider and withdraw these rejections

A. AAPA and James, taken singly or in combination, do not teach or suggest the following claim limitations.

Applicants respectfully assert that AAPA and James, taken singly or in combination, do not teach or suggest "a program appliance comprising a program attachable in data communication with the computer; and a data storage appliance attachable in data communication with the computer" as recited in claim 1. The Examiner cites page 6, lines 14-20 of Applicants' Specification as teaching the above-cited claim limitation. Office Action (2/01/2006), page 4. Applicants respectfully traverse and assert that Applicants' Specification instead teaches that this method of operation is in stark contrast to the prior art, under which a backup program would be installed on the computer which would then instruct the computer to copy data from the computer hard drive to a data storage appliance. Applicants' Specification, page 6, lines 16-19<sup>1</sup>. There is no language in the cited passage directed to prior art that teaches a program appliance comprising a program attachable in data communication with the computer. Neither is there any language in the cited passage directed to prior art that teaches a data storage appliance attachable in data communication with the

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<sup>1</sup> It is noted that only lines 16-19 on page 6 of Applicants' Specification refers to the prior art. The rest of the teaching on page 6 of Applicants' Specification refers to the detail description and is not admitted prior art.

computer. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 1, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that AAPA and James, taken singly or in combination, do not teach or suggest "wherein the program is configured to copy the files from the hard drive to the data storage appliance without installation of the program on the hard drive" as recited in claim 1. The Examiner cites [0004]; [0011] and [0032] of James as teaching the above-cited claim limitation. Office Action (2/01/2006), page 4. Applicants respectfully traverse.

James instead teaches a portable device for attachment to a personal computer into which data stored in the computer's RAM or on its hard drive may be downloaded. [0004]. James further teaches a memory device containing at least one applications software package and optional associated data, the applications software package being configured to run from the memory device, upon connection thereof to the host computer, by making use of the operating system and processor of the host computer. [0011]. James further teaches that because the applications software and associated data may run from the portable memory device rather than being copied onto the computer's hard drive or other permanent memory storage means, security is much improved, since potentially confidential or personal information is not copied into the computer's permanent memory storage means leaving it vulnerable to potential access by a subsequent user. [0032]. Hence, James teaches a portable memory device that contains application software and associated data where the applications software package is configured to run from the memory device, upon connection thereof to the host computer, by making use of the operating system and processor of the host computer.

There is no language in the cited passages that teaches a program in a program appliance configured to copy files from a hard drive to data storage appliance. Instead, the cited passages simply teach software in a portable memory device being operable to run data from the memory device instead of having to copy such data onto

the computer's hard drive. Neither is there any language in the cited passages that teaches a program in a program appliance configured to copy files from a hard drive to data storage appliance without installation of the program on the hard drive. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 1, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Claims 2-7 each recite combinations of features of claim 1, and thus are patentable over AAPA in view of James for at least the reasons that claim 1 is patentable over AAPA in view of James. Claims 2-7 recite additional features, which, in combination with the claims upon which they depend, are patentable over AAPA in view of James.

For example, AAPA and James, taken singly or in combination, do not teach or suggest "wherein the program appliance and the data storage appliance are the same appliance" as recited in claim 2. The Examiner cites Figure 2 of AAPA and the memory device of James. Office Action (2/01/2006), page 5. Applicants respectfully traverse.

Figure 2 of Applicants' Specification is not prior art. Figure 2 is directed to an embodiment of the present invention of a hardware configuration. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 2, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Further, the Examiner has not directed Applicants to any language in James to support the assertion that the memory device of James is both a program appliance and a data storage appliance. The Examiner must provide a basis in fact and/or technical reasoning to support the assertion that the memory device of James is both a program appliance and a data storage appliance. *See Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that James inherently teaches that the memory device of James is both a program appliance and a data storage appliance, and that it would be so recognized by persons of ordinary skill. *See In re Robertson*,

169 F.3d 743, 745 (Fed. Cir. 1999). Since the Examiner has not provided any such objective evidence, the Examiner has not presented a *prima facie* case of obviousness for rejecting claim 2. M.P.E.P. §2143.

Applicants further assert that AAPA and James, taken singly or in combination, do not teach or suggest "wherein the program is further configured to execute automatically upon the program appliance being attached to the computer" as recited in claim 3 and similarly in claim 7. The Examiner cites [0011] and [0013]-[0014] of James as teaching the above-cited claim limitation. Office Action (2/01/2006), page 5. Applicants respectfully traverse and assert that James instead teaches a memory device containing an applications software package and optional associated data, the applications software package being configured to run from the memory device, upon connection thereof to the host computer, by making use of the operating system and processor of the host memory. [0011]. James further teaches that the discrete, non-volatile memory device is preferably portable, and even more preferably lightweight and small in comparison to the host computer. [0013]. James further teaches that the memory device is advantageously configured as a memory device that may be 'hot-plugged' to a host computer by way of a USB port or other I/O port. [0014]. Hence, James teaches a portable memory device that can be hot-plugged to a host computer by way of a USB port or other I/O port. There is no language in the cited passages that teaches that the program (configured to copy the files from the hard drive to the data storage appliance) is configured to execute automatically upon the program appliance being attached to the computer. The Examiner must specifically point out in James where James allegedly teaches the "program" referred to in the claims as well as the "program appliance" and "computer" referred to in the claims pursuant to 37 C.F.R. §1.104(c)(2). Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 3 and 7, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that AAPA and James, taken singly or in combination, do not teach or suggest "wherein the program is further configured to copy the files from the data storage appliance to the hard drive without installation of

the program on the hard drive" as recited in claim 4. The Examiner asserts that James teaches the above-cited claim limitation but does not cite to any passage in James as allegedly teaching the above-cited claim limitation. In order to establish a *prima facie* case of obviousness, the Examiner must provide evidence that the cited art (AAPA and James) teaches or suggests all of the claim limitations, including the above-cited claim limitation. M.P.E.P. §2143. Since the Examiner has not provided any such evidence, the Examiner has not established a *prima facie* case of obviousness in rejecting claim 4. M.P.E.P. §2143.

Applicants further assert that AAPA and James, taken singly or in combination, do not teach or suggest "a network in data communications with the computer; and a server computer in data communications with the network, wherein the data communication between the data storage appliance and the computer is provided through the server" as recited in claim 5. The Examiner cites [0003] of James as teaching the above-cited claim limitation. Office Action (2/01/2006), page 6. Applicants respectfully traverse and assert that James instead teaches that data and applications may be transferred by way of modems and a telecommunications network. [0003]. There is no language in the cited passage that teaches a network in data communications with the computer (where the computer is in data communication with program of the program appliance). Neither is there any language in the cited passage that teaches a server computer in data communications with the network. Neither is there any language in the cited passage that teaches that the data communication between the data storage appliance and the computer is provided through the server. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 5, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that AAPA and James, taken singly or in combination, do not teach or suggest "wherein the program is further configured to copy the files from the data storage appliance to the hard drive without installation of the program on the hard drive" as recited in claim 6. The Examiner asserts that AAPA and James, taken together, teach the above-cited claim limitation. Office

Action (2/01/2006), page 4. However, the Examiner has not specifically cited to a passage in either AAPA or James as teaching the above-cited claim limitation.. In order to establish a *prima facie* case of obviousness, the Examiner must provide evidence that the cited art (AAPA and James) teaches or suggests all of the claim limitations, including the above-cited claim limitation. M.P.E.P. §2143. Since the Examiner has not provided any such evidence, the Examiner has not established a *prima facie* case of obviousness in rejecting claim 6. M.P.E.P. §2143.

As a result of the foregoing, Applicants respectfully assert that there are numerous claim limitations not taught or suggested in the cited prior art, and thus claims 1-7 are patentable over AAPA in view of James. M.P.E.P. §2143.

- B. The Examiner's motivation for modifying AAPA with James to include the missing claim limitation of claim 1 is insufficient to establish a *prima facie* case of obviousness in rejecting claim 1.

Most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention may often be found in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner admits that AAPA does not teach "wherein the program is configured to copy the files from the hard drive to the data storage appliance without installation of the program on the hard drive" as recited in claim 1. Office Action (2/01/2006), page 5. The Examiner's motivation for modifying AAPA with James to include the above-cited claim limitation is "in order not to copy potentially confidential or personal information into the computer's permanent memory storage means, leaving it vulnerable to potential access by a subsequent use of the computer system, so that the security is much improved<sup>2</sup>." Office Action (2/01/2006), page 5. The Examiner's motivation is insufficient to support a *prima facie* case of obviousness for at least the reasons stated below.

The Examiner's motivation ("in order not to copy potentially confidential or personal information into the computer's permanent memory storage means, leaving it vulnerable to potential access by a subsequent use of the computer system, so that the security is much improved") does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify AAPA to include the missing claim limitation of claim 1. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1-7. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

The Examiner cites column 6, lines 14-20 of Applicants' Specification for the teaching of AAPA. Office Action (2/01/2006), page 4. Applicants' Specification teaches that this method of operation is in stark contrast to the prior art, under which a backup program would be installed on the computer which would then instruct the computer to copy data from the computer hard drive to a data storage appliance. Applicants' Specification, page 6, lines 16-19. The Examiner has not provided any reasons as to why one skilled in the art would modify AAPA, which teaches a backup program would be installed on the computer which would then instruct the computer to copy data from the computer hard drive to a data storage appliance, to have program configured to copy the files from the hard drive to the data storage appliance without installation of the program on the hard drive (missing claim limitation of

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<sup>2</sup> The Examiner appears to be citing from [0032] of James.

AAPA). The Examiner's motivation ("in order not to copy potentially confidential or personal information into the computer's permanent memory storage means, leaving it vulnerable to potential access by a subsequent use of the computer system, so that the security is much improved") does not provide such reasoning. The Examiner has not explained how "not copying potentially confidential or personal information into the computer's permanent memory storage means, leaving it vulnerable to potential access by a subsequent use of the computer system, so that the security is much improved" relates to a backup program installed on the computer which would then instruct the computer to copy data from the computer hard drive to a data storage appliance. Neither has the Examiner explained how "not copying potentially confidential or personal information into the computer's permanent memory storage means, leaving it vulnerable to potential access by a subsequent use of the computer system, so that the security is much improved" relates to having a program configured to copy the files from the hard drive to the data storage appliance without installation of the program on the hard drive. The Examiner must provide objective evidence in modifying AAPA to include the missing limitation of claim 1. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Instead, the Examiner is merely relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness in rejecting claims 1-7. *Id.* Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 1-7. *Id.*

C. Examiner has not provided motivation for modifying AAPA to include the limitations of claims 3, 4, 5 and 7.

In order to establish a *prima facie* case of obviousness, the Examiner must submit some suggestion or motivation to modify the reference to combine reference teachings. M.P.E.P. §2143. The Examiner admits that AAPA does not teach the limitations of claims 3, 4, 5 and 7. Office Action (2/01/2006), pages 5-6. The Examiner modifies AAPA with James to include the missing claim limitations of claims 3, 4, 5 and 7. Office Action (2/01/2006), pages 5-6. However, the Examiner fails to present any motivation for modifying AAPA to include the missing claim limitations of claims 3, 4, 5 and 7. Hence, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 3, 4, 5 and 7. M.P.E.P. §2143.



- D. Examiner needs to clarify motivation for modifying AAPA with James to include the limitation of claim 6 pursuant to 37 C.F.R. §1.104(c)(2).

Applicants respectfully request the Examiner to particularly point out whether or not AAPA does not teach the limitation of claim 6 pursuant to 37 C.F.R. §1.104(c)(2). If AAPA does not teach the limitation of claim 6, Applicants respectfully request the Examiner to particularly point out where James allegedly teaches the limitation of claim 6 as well as to particularly provide the motivation for modifying AAPA to include the limitation of claim 6 pursuant to 37 C.F.R. §1.104(c)(2). The Examiner is reminded that in order to establish a *prima facie* case of obviousness, the Examiner must provide a motivation to modify AAPA with James to include the missing limitation of claim 6 (assuming that AAPA does not teach claim 6 and Examiner asserts that James allegedly teaches the limitation of claim 6) in order to establish a *prima facie* case of obviousness. M.P.E.P. §2143.

II. CONCLUSION:

As a result of the foregoing, it is asserted by Applicants that claims 1-7 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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